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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/563,799	07/25/2006	Hiroshi Maegawa	R2184.0475/P475	7558
24998	7590	07/17/2009		
DICKSTEIN SHAPIRO LLP 1825 EYE STREET NW Washington, DC 20006-5403			EXAMINER AGUSTIN, PETER VINCENT	
			ART UNIT	PAPER NUMBER
			2627	
			MAIL DATE	DELIVERY MODE
			07/17/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/563,799	<b>Applicant(s)</b> MAEGAWA, HIROSHI	
	<b>Examiner</b> Peter Vincent Agustin	<b>Art Unit</b> 2627	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 May 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-96 is/are pending in the application.
- 4a) Of the above claim(s) 1-93 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 94-96 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-96 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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### **DETAILED ACTION**

1. This application is a national stage entry of PCT/JP04/03420, filed on March 15, 2004.
2. Claims 1-96 are currently pending.

#### ***Election/Restrictions***

3. Applicant's election with traverse of Group VII (claims 94-96) in the reply filed on May 14, 2009 is acknowledged. The traversal is on the ground(s) that examination of at least claims 87-93 together with the elected claims would not impose a serious burden on the examiner. This is not found persuasive because serious burden is evident from the groups of claims having mutually exclusive characteristics and not having a single general inventive concept under PCT Rule 13.1. For example, as noted in the requirement, Groups VI (claims 87-93) and VII (claims 94-96) lack the same or corresponding special technical features under PCT Rule 13.2 (see chart on page 4). Examination of both sets of claims would require the examiner to formulate separate search strategies for each set, because references applicable to one set may not be applicable to the other set, and therefore, this poses a serious burden on the examiner.

The requirement is still deemed proper and is therefore made FINAL.

4. Claims 1-93 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on May 14, 2009.

#### ***Priority***

5. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

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***Specification***

6. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

7. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 94-96 are rejected under 35 U.S.C. 102(e) as being anticipated by Kondo (US 2003/0053405).

In regard to claim 94, Kondo discloses an information recording medium (Figure 17) having a plurality of recording layers (15, 17) recordable with data by irradiating light thereon (91), and a track on each recording layer includes wobbles of modulated information (see abstract), wherein: the wobbles are recorded with FSK modulated information (abstract: “frequency shift modulation”), PSK modulated information or FSK+PSK modulated information as layer information indicating a place or position of each recording layer (paragraph 0240: “address recording on the first layer is executed by frequency shift modulation with saw tooth

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wave type 1 as its basic wave while the address recording on the second layer is executed by frequency shift modulation with saw tooth wave type 2 as the basic wave”).

In regard to claim 95, Kondo discloses “the information recording medium as claimed in claim 94” (as noted above). The limitation “when the layer information is the FSK+PSK modulated information” is not considered to be a positive recitation since it is claimed only in the alternative (see base claim 94), and therefore it is not given patentable weight.

In regard to claim 96, Kondo discloses “the information recording medium as claimed in claim 94” (as noted above). The limitation “when the layer information is the PSK modulated information” is not a considered to be a positive recitation since it is claimed only in the alternative (see base claim 94), and therefore it is not given patentable weight.

The rejections of claims 95 & 96 can be overcome by amending these claims to positively recite the noted limitations. For example, claim 95 can be amended to indicate “wherein the layer information is FSK+PSK modulated, and the wobbles are further recorded with PSK modulated information as address information”.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Okada et al. (US 5,946,279) disclose an optical disk having a wobble signal obtained from performing FSK modulation using a bi-phase modulation signal which is information such as a disk address.

Kondo (US 2003/0072251) discloses a recording medium wherein a wobbling groove corresponding to the read only area of the recording medium contains a wobbling groove

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modulated by the frequency-shift keying method, and wherein another wobbling groove corresponding to the recording and reproducing area of the recording medium contains a wobbling groove modulated by the phase-shift keying method.

Shoji et al. (US 2003/0031098) disclose a substrate-discrimination means for discriminating whether a servo means is performing an operation on either a first or a second substrate according to a result provided by a wobble polarity discrimination means.

Kojima (US 2002/0031063) discloses an optical disk having two layers wherein a wobbling signal of the first layer is a signal having a single frequency, and a wobbling signal of the second layer is a signal whose phase is inverted every two cycles.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Vincent Agustin whose telephone number is (571) 272-7567. The examiner can normally be reached on Monday-Thursday 8:30 AM-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea Wellington can be reached on (571) 272-4483. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Peter Vincent Agustin/  
Primary Examiner, Art Unit 2627